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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/622,478	07/21/2003	Jean-Christophe Simon	032487-004	4522

7590 05/02/2007

BURNS, DOANE, SWECKER & MATHIS, L.L.P.
P.O. Box 1404
Alexandria, VA 22313-1404

EXAMINER	
HANDY, NIKKI R	

ART UNIT	PAPER NUMBER
1616	

MAIL DATE	DELIVERY MODE
05/02/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/622,478	SIMON ET AL.	
	Examiner	Art Unit	
	Nikki Handy	1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-48* is/are pending in the application.

4a) Of the above claim(s) *1-17,22-30,33-44,46 and 47* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *18-21,31,32 and 45* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *See Continuation Sheet*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :7/21/2003, 6/10/2005, 5/26/2006 and 3/12/2007.

DETAILED ACTION

Claims 1-55 are pending.

Claims 49-55 are hereby expressly withdrawn from consideration as being directed to a nonelected invention.

Applicant's election with traverse of Group I and the species (a substrate-glass; a metal or metal compound-Ag (silver); a multilayer interference structure-$Fe_2O_3/SiO_2/Fe_2O_3/SiO_2/Fe_2O_3$; a makeup composition-lip makeup and a subspecies of the substrate-glass substrate coated with silver) in the reply filed on March 12, 2007 is acknowledged. The traversal is on the ground(s) that (a) the Applicant does not believe that the Examiner has shown that the process as claimed can be practiced with a materially different product where the Groups all relate to a novel makeup for creating an optical volumizing effect and (b) the Applicant believes that Groups I-IV do not necessitate different fields of search. This is not found persuasive because the Examiner is convinced that the process can be practiced with a materially different product, such as, a kit for making up the skin, lips, hair and/or integuments. Further the Examiner is not convinced that the Groups all relate to a **novel** makeup that creates an optical volumizing effect. The Examiner disagrees with the applicant that the Groups would not necessitate different fields of search. Although the Groups are classified in the same class and subclass, there would be undue burden to search these Groups in the non-patent literature. For example, Group II and Group IV are patentably distinct. The different concepts of these groups in reference to a non-patent literature search would result in an undue burden on the examiner.

Therefore, the requirement is still deemed proper and is therefore made **FINAL**.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 18-21, 31, 32 and 45 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 3, 5, 10, 11, 31, 32 and 45 of copending Application No. US 2005/0118122 A1. Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications claim a goniochromatic/light reflecting cosmetic makeup composition. The scope of the application differs from the claims in US Application No. US 2005/0118122 A1 in that US Application No. '122 recites a goniochromatic/light reflecting cosmetic makeup composition comprising (a) at least one goniochromatic coloring agent and additional components cited in instant claim 1 of US Application No. '122. US Application No.'122 is the subgenus of Claim 1 in the instant application (the genus). The composition claims in both applications use the phrase, **comprising** (a) at least one goniochromatic coloring agent. The components of the instant application (the genus) in Claim 1 are a goniochromatic/light reflecting cosmetic makeup composition, comprising (a) at least one goniochromatic coloring agent suited for creating a goniochromatic colored background and (b) an amount of light reflective particles suited for creating highlight points that are visible to the naked eye, formulated into (c) a topically applicable, physiologically acceptable medium. The additional components of the subgenus in US Application No. '122 are listed in Claim 1. The additional unrecited components

of the subgenus are (i), (ii), (iii) and (iv). It would have been obvious to one of ordinary skill in the art to include the additional components in US Application No. '122 (the subgenus) into the composition of the instant application because the subgenus is encompassed in the genus which makes claim to a goniochromatic/light reflecting cosmetic makeup composition.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Applicant has provided evidence in this file showing that the invention was owned by, or subject to an obligation of assignment to, the same entity as Sabine et al. (US 2002/0064509 A1) at the time this invention was made, or was subject to a joint research agreement at the time this invention was made. However, reference US 6,491,932 B1 additionally qualifies as prior art under another subsection of 35 U.S.C. 102, and therefore, is not disqualified as prior art under 35 U.S.C. 103(c).

Applicant's Invention

Applicant may overcome the applied art either by a showing under 37 CFR 1.132 that the invention disclosed therein was derived from the invention of

this application, and is therefore, not the invention "by another," or by antedating the applied art under 37 CFR 1.131.

The references are available under 102(e).

Claims 18-21, 31-32 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ramin et al. (US Patent No. 6,491,932 B1) in view of Grimm et al. (US 2002/0064509 A1).

The applicant claims a goniochromatic/light reflecting cosmetic makeup composition comprising (a) at least one goniochromatic coloring agent, (b) an amount of light reflective particles suited for creating highlight points that are visible to the naked eye, formulated into (c) a topically applicable, physiologically acceptable medium.

Determination of the scope and content of the prior art

(MPEP 2141.01)

Ramin et al. teach additional components, such as, a cosmetic make-up composition comprising, in a cosmetic acceptable medium, a dyestuff comprising glass particles coated with at least one metallic coat. The at least one metallic coat can be formed from at least one metal, such as, **silver**, etc. See Column 2, lines 10-11.

Ascertainment of the difference between the prior art and the claims

(MPEP 2141.01)

Ramin et al. do not teach a lipstick as a cosmetic composition or an interferential multilayer structure. It is for this reason that Grimm is joined. Grimm et al. teach a lipstick that contributes to the goniochromatic effect of a cosmetic

composition. Grimm further teaches an interferential multilayer structure having at least one goniochromatic pigment, such as, $Fe_2O_3/SiO_2/Fe_2O_3/SiO_2/Fe_2O_3$.

Finding of prima facie obviousness

Rational and Motivation (MPEP 2142-2143)

It would have been obvious to one having ordinary skill in the art at the time of the invention to combine the teachings of Ramin and Grimm. One would have been motivated to combine the teachings because Grimm teaches a lipstick as a cosmetic composition and the interferential multilayer structure as a goniochromatic pigment to achieve a goniochromatic effect.

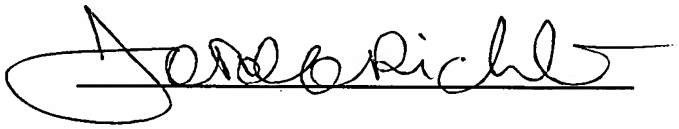
Telephonic Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nikki Handy whose telephone number is (571) 272-9923. The examiner can normally be reached on Monday-Friday 8:30 am-5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on (571) 272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Nikki Handy
Patent Examiner
Art Unit 1616



Johann Richter, Ph. D., Esq.
Supervisory Patent Examiner
Technology Center 1600